

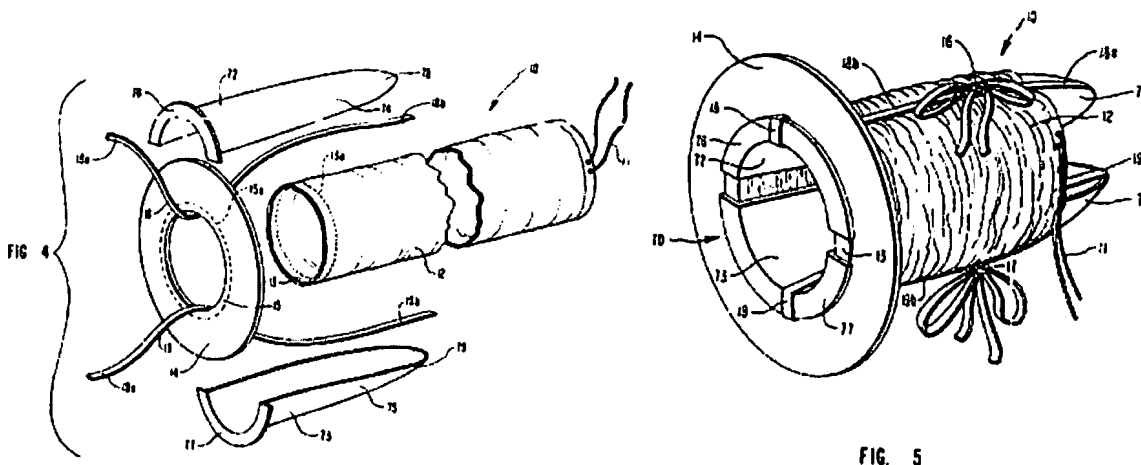
REMARKS

Claims 1-3 and 5-33 are currently pending in this application. By this amendment, Claims 1, 5-7, 11 and 21 have been amended and Claims 31-33 have been added. No new matter has been added to this application by this amendment. In view of the amendments above and the remarks to follow, reconsideration and allowance of this application are respectfully requested.

Claims 1, 11, 13 and 14 were previously amended to correct the lack of antecedent basis, thereby overcoming the rejection of Claims 1-3 and 5-20 under 35 U.S.C. § 112, second paragraph.

Claims 1-3 and 5-17 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,665,073 to Bulow et al. ("Bulow"). Under 35 U.S.C. § 102(b), "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. Applicants respectfully submit that Bulow fails to disclose each and every element recited in independent Claim 1, either expressly or inherently.

Bulow discloses a protective sheath 10 shown in FIGS. 4 and 5, reproduced below, including, *inter alia*, a sheath guide 70 including a pair of opposed guide member 72 and 73. Guide members 72 and 73 are configured with semi-cylindrical surfaces 74 and 75 terminating at the proximal ends in semicircular flanges 76 and 77, respectively. Semicircular flanges 76 and 77 collectively provide a bonding surface for bonding the distal end 13 of a fabric sleeve 12 to shield 14.



The specification continues at, col. 7 lines 18,

In particular and with specific reference to FIG. 4, the distal end 13 of fabric sleeve 12 that is to be bonded to shield 14 is shown by a broken line at 13a while the bonding surface 15 on shield 14 to which distal end 13 is to be bonded is delineated by a broken line 15a. Semicircular flanges 76 and 77 in effect sandwich distal end 13 against bonding surface 15 so as to present to the user of protective sheath 10 a smooth profile through which collective conduits 60 can be passed.

Thus, sheath guide 70 and shield 14 of protective sheath 10 of Bulow is securely affixed to fabric sleeve 12. Applicants respectfully submit that Bulow does not disclose each and every element recited in Claim 1. More specifically, Bulow does not disclose a surgical instrument which includes a cover deployment member in releasable engagement with the cover, as recited in Claim 1. For this reason, Applicants submit that Bulow does not anticipate Claim 1 and Claim 1 is in condition for allowance.

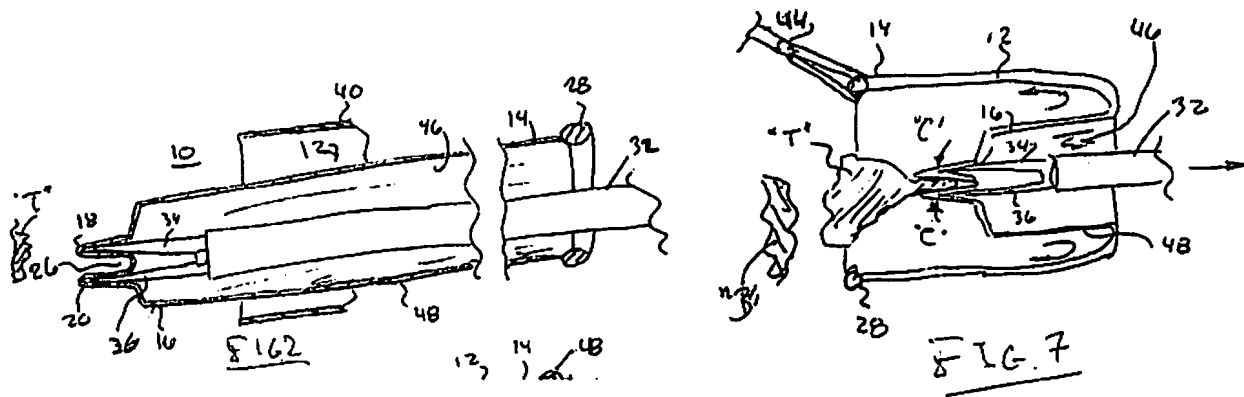
Claims 2, 3 and 5-17 depend either directly or indirectly from Claim 1. For at least the reasons discussed above with respect to Claim 1, Applicants believe that Claims 2, 3 and 5-17

are also in condition for allowance.

Claims 21, 25 and 26 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0139767 to Jespersen ("Jespersen"). Claim 21 recites, a method for performing a surgical procedure including, *inter alia*, "subsequently removing the surgical instrument from the surgical site, while maintaining the cover at least partially over the tool assembly".

Jespersen discloses an organ or tissue retrieval bag arrangement 10 shown in FIGS. 2 and 7, reproduced below, including a bag 12 having a first or proximal end 14 and a second or distal end 16. The distal end 16 of the retrieval bag 12 has a pair of generally tapered tubular-shaped grasper receiving tips 18 and 20 extending therefrom to receive grasper jaws 34 and 36, respectively. In use, grasper device 32, including retrieval bag 10 thereabout, is inserted into a patient through a trocar or other opening in the body until the proximal end 14, including beading 28, is received past the distal end of the trocar. The tissue to be excised is next grasped within jaws 34 and 36 of grasper device 32. Once the tissue has been excised, a second grasper device 44 is used to grab beading 28 at the proximal end 14 of retrieval bag 12 and pull retrieval bag 12 in a distal direction about the excised tissue. The specification continues, at paragraph [0041],

... The original outer side 48 of the organ retrieval bag 12 thus becomes the inner side of the tissue containment bag once it has been pulled distally from the grasper device 32 and about the tissue/organ "T" being retrieved, as exemplified in FIG. 7. The tissue "T" then may be safely enveloped within the everted organ retrieval bag 12 and removed through the trocar 40 or surgical opening in the patient, without loss of any contaminated fluid or without contaminating tissue components escaping therefrom.



Thus, organ retrieval bag 12 of Jespersen is not maintained at least partially over the grasper jaws 34 and 36 as grasper device 32 is removed from the surgical site. Instead, as discussed in detailed above, retrieval bag 12 is removed from grasper jaws 34 and 36 prior to removal of grasper device 32 from the surgical site. Subsequently, retrieval bag 12 and grasper device 32 are removed separately from the surgical site.

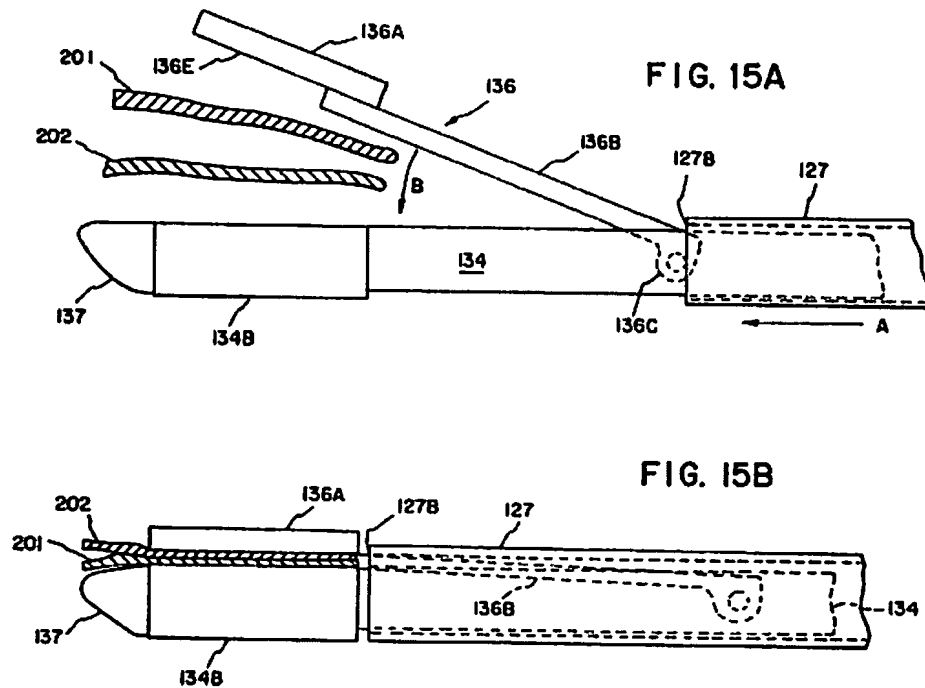
Applicants respectfully submit that Jespersen does not disclose each and every element recited in Claim 21. More specifically, Jespersen does not disclose subsequently removing the surgical instrument from the surgical site, while maintaining the cover at least partially over the tool assembly. For this reason, Applicants submit that Jespersen does not anticipate Claim 21 and Claim 21 is in condition for allowance.

Claims 25 and 26 depend either directly or indirectly from Claim 21. For at least the reasons discussed above with respect to Claim 21, Applicants believe that Claims 25 and 26 are also in condition for allowance.

Claims 27-30 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,318,221 to Green et al. ("Green"). By the present amendment, Claims 27-29 have been

cancelled. Claim 30 recites a surgical instrument including, inter alia, a shell assembly having a plurality of surgical staples and an elongated cover movable from a first proximal position to a second position to cover the stationary shell assembly.

With reference to FIGS. 15A and 15B, reproduced below, Green discloses an instrument having a housing 134 and an anvil member 136. A cartridge assembly 137 is received on a relatively wider section 134B of housing 134. Cartridge assembly 137 includes a plurality of staples (not shown). A collar 127 is slidably positioned over a proximal end of housing 134 and anvil 136 to approximate the housing and the anvil towards one another.



Applicants respectfully submit that Green does not disclose each and every element recited in Claim 30. More specifically, Green does not disclose a surgical instrument including a shell assembly having a plurality of surgical staples and an elongated cover movable from a first proximal position to a second position to cover the stationary shell assembly. As discussed above, Green discloses an instrument including a housing 134 having a relatively wider distal end 134B configured to receive a cartridge assembly 137. Collar 127 is configured to slide distally to approximate anvil 136 towards housing 134, and its movement thereby advances over a proximal end of housing 134. However, as shown in FIG. 15B, collar 127 includes a diameter smaller than that of distal end 134B and anvil plate 136, thereby preventing collar 127 from covering distal end 134B and anvil plate 136. Therefore, collar 127 is not movable from a first position to a second position to cover the portion of housing 134 including cartridge assembly 137 (distal end 134B). For this reason, Applicant submits that Green does not anticipate Claim 30 and that Claim 30 is in condition for allowance.

Claims 18-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bulow in view of U.S. Patent No. 6,024,741 to Williamson et al. ("Williamson"). Claims 18-20 depend indirectly from Claim 1. Williamson does not provide any disclosure which cures the deficiencies of Bulow with respect to Claim 1. For at least the reasons discussed above with respect to Claim 1, Applicant believes that Claims 18-20 are also in condition for allowance.

By the present amendment, Applicants have added Claims 31-33. No new matter has been added by the additional claims. Claims 31-33 depend from Claim 30, therefore, for at least the reasons Claim 30 is in condition for allowance, Claims 31-33 are also in condition for allowance.

Appl. No. 10/522,914
Amdt. Dated: November 24, 2008
Reply to Office Action of June 25, 2008

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims pending in the application, namely claims 1-3 and 5-33, are in condition for allowance. Accordingly, early and favorable reconsideration of this application is respectfully requested. Should the Examiner feel that a telephone or personal interview may facilitate resolution of any remaining matters, he is respectfully requested to contact Applicant's attorney at the number indicated below.

CARTER, DELUCA, FARRELL & SCHMIDT, LLP
445 Broad Hollow Road - Suite 420
Melville, New York 11747
(631) 501-5700

Respectfully submitted,

Christopher G. Trainor

Christopher G. Trainor
Reg. No. 39,517
Attorney for Applicant(s)

Correspondence Address:
Covidien
60 Middletown Avenue
North Haven, CT 06473